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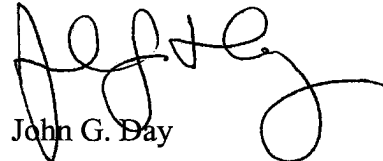
The Honorable Kent A. Jordan  
United States District Court  
844 King Street  
Wilmington, DE 19801

Re: In re '318 Patent Infringement Litigation,  
Civil Action No. 05-356-KAJ (Consolidated)

Dear Judge Jordan:

At the Court's request, I enclose a copy of the transcript of the discovery dispute teleconference that Your Honor held in the above matter during the Rule 30(b)(6) deposition of plaintiff Synaptech, Inc. on August 30, 2006.

Respectfully,

A handwritten signature in black ink, appearing to read "John G. Day", with a long horizontal flourish extending to the right.

John G. Day

JGD/nml  
Enclosure  
172931.1

cc: All defense counsel (via electronic mail; w/ attachment)

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7 (Brief recess.)  
8 (Telephone conference with Hon.  
9 Jordan.)  
10 THE CLERK: The docket item  
11 number for that deposition notice is  
12 252 -- it is 06 -- it is 06 -- I'm sorry.  
13 05356.  
14 HON. JORDAN: All right, notice  
15 of deposition of plaintiff synaptech. Is  
16 that the document?  
17 MR. PAPPAS: Yes, sir. Yes,  
18 your Honor.  
19 HON. JORDAN: All right. I have  
20 that in front of me and why don't we go  
21 ahead and whoever arranged for this call  
22 take the ball and tell me what the problem

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23 is and what it is you want me to do about  
24 it and then I'll take the position from  
25 the other side.

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2 MR. PAPPAS: Very well. It's  
3 George Pappas, who will speak on behalf of  
4 plaintiff synaptech.

5 We are currently having taken a  
6 30 (b) (6) notice, or deposition of  
7 synaptech, Inc., the corporation, by the  
8 defendants Bar and AlphaPharm. Synaptech  
9 has produced its only employee and  
10 executive, Dr. Bonnie Davis, who also  
11 happens to be the inventor of the '318  
12 patent.

13 As your Honor may recall,  
14 Dr. Davis has already been deposed in her  
15 personal capacity for 14 hours over a  
16 two-day time period by all of the  
17 defendants, and at that time there were 7  
18 defendants participating in the case.

19 Subsequent to that deposition, a  
20 30 (b) (6) notice that we're about to hear  
21 today was served on Synaptech. Your Honor  
22 may recall that we had a hearing before  
23 you on July 11th where we noted, we on  
24 behalf of synaptech, noted an objection to  
25 read deposition in effect of Dr. Bonnie

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2 Davis and your Honor ruled that a  
3 30 (b) (6) could go forward and that  
4 Synaptech was to produce an individual  
5 prepared to testify about topics  
6 appropriate to a 30 (b) (6) witness.  
7           Synaptech promptly complied with  
8 your Honor's ruling and Dr. Bonnie Davis  
9 is here today prepared to testify and has  
10 been testifying, your Honor, about 30  
11 topics that are all in this notice.  
12 Either by reference to documents or to the  
13 extent Synaptech has records, she has and  
14 is prepared to testify.  
15           The difficulty has arisen, your  
16 Honor, because -- and I made an oral  
17 motion for protective order -- and that's  
18 what we're asking your Honor to grant, as  
19 I'll address now. I have not instructed  
20 the witness not to answer. I've followed  
21 the rules and made an oral motion for  
22 protective order and sought the  
23 intervention of your Honor as soon as you  
24 are able to accommodate us, and we  
25 certainly appreciate that, on such short

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2 notice.

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There have been a series of  
questions this morning, your Honor, that  
fall outside, clearly outside the scope of  
any of the 30 topics of the deposition.  
And when I have asked counsel for  
AlphaPharm and Bar to make a proffer as to  
how they're within the scope of any of the  
topics, which we have prepared Dr. Davis  
on, as is our obligation under 30 (b) (6),  
they have repeatedly and steadfastly  
refused to do so. I've asked them to make  
a proffer in an attempt to work out a  
discovery dispute so we wouldn't have to  
trouble your Honor, but they have refused  
to do so.

18 Their position, as expressed to  
19 me on the record, has been that, to the  
20 extent Dr. Davis said "I don't know" in  
21 her personal capacity to any question  
22 during two days in February, they are  
23 entitled to interrogate her about that  
24 even if it is outside the scope of any of  
25 the topics of the 30 (b) (6) deposition.

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2 And I have a specific example.

3

If your Honor will note  
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4 paragraph -- topic number 1 reads:  
5 "Synaptech's knowledge of P.A. Baskher's  
6 article, 'Medical Management of Dementia,'  
7 in the Antiseptic Journal." And what they  
8 asked us to prepare a corporate  
9 representative on is whether or not that  
10 article was cited by any United States or  
11 foreign patent office or other tribunal in  
12 connection with the prosecution of the  
13 '318 patent or any foreign equivalent of  
14 the '318 patent and Synaptech's knowledge  
15 of any statements or arguments made to  
16 explain Baskher.

17 Now, it has been testified to  
18 that Dr. Davis, in accordance with her  
19 30 (b) (6) obligations, checked with the  
20 Synaptech records, as they were held by  
21 her patent attorney, John Richards, who  
22 advised her that the P.A. Baskher article  
23 was never cited in connection with the  
24 '318 patent by the United States Patent  
25 Office or any foreign tribunal in

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2 connection with the prosecution of the  
3 '318 patent.  
4 Notwithstanding that testimony,  
5 counsel for the defendants attempted to  
6 ask her general questions about the

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7 Baskher article. That is not a topic,  
8 your Honor, of any of the 30 categories of  
9 the deposition.

10 Then, to make matters even more  
11 beyond the scope, they placed before her a  
12 document previously identified as a  
13 defendants' exhibit, entitled "Translation  
14 of Nullity Action Filed in Germany by  
15 Waldheim on 1 June 1995."

16 Now, first, your Honor, a  
17 nullity action is not part of the  
18 prosecution of any patent. It's an action  
19 that takes place in Europe after a patent  
20 has been granted. If the defendants  
21 wanted to inquire into that and get the  
22 Synaptech position, they could have put us  
23 on notice. We've spent an extremely high  
24 amount of time preparing this witness to  
25 testify on 30 topics. They did not so

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1  
2 note it.

3 To make matters, in our view,  
4 your Honor, worse, in the nullity action,  
5 which is not an action, by the way, by a  
6 foreign tribunal, the document they put  
7 before her is the translation of a  
8 position taken by another company called  
9 Waldheim, in Europe, so it's not an action

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10 taken by a European patent authority.  
11 There are certain references cited in  
12 there by the Waldheim company in bringing  
13 the nullity action. Not one of the those  
14 references cited in that nullity action  
15 are contained in paragraphs 1, 2, or 3 of  
16 the corporate notice that the defendants  
17 have served.

18 The relief, therefore, we ask,  
19 your Honor, is that my oral motion on  
20 behalf of Synaptech be granted and that  
21 the 30 (b) (6) deposition, as your Honor  
22 ordered, go forward on all 30 of the  
23 topics, which, to the extent Synaptech has  
24 knowledge and documents, Dr. Davis is  
25 prepared to testify, but that your Honor

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2 respectfully direct the defendants that  
3 under the guise of a 30 (b) (6) deposition  
4 they are not entitled to ask her, as the  
5 corporate representative, about any  
6 question in February that she may not have  
7 known the answer to if it's outside the  
8 scope of the 30 (b) (6) topics.

9 What we did in preparing her,  
10 your Honor, when you said in your  
11 transcript they were entitled to do a  
12 properly prepared 30 (b) (6) witness, we



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13 went back through the transcript of  
14 February, we found the instances where  
15 Dr. Davis said she did not know the  
16 answer, and to the extent those "do not  
17 know" answers were clearly within the  
18 purview of any of the 30 topics in the  
19 corporate notice, we made sure that she  
20 was prepared. And she's prepared on much  
21 more, because these 30 topics, your Honor,  
22 go far beyond some of the areas that were  
23 covered in February.

24 HON. JORDAN: Okay.

25 MR. PAPPAS: That's our relief

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1

2 your Honor.

3 HON. JORDAN: I'm pretty sure I  
4 got your position. Who's speaking on  
5 behalf of Bar and AlphaPharm? I assume  
6 you have a joint position.

7 (Via Telephone.)

8 MR. GRACEY: Yes, your Honor.

9 This is Taras Gracey on behalf of  
10 Mr. Bar. Mr. Bernstein may want to add  
11 something on each of the several things,  
12 your Honor.

13 Thank you, first of all, for  
14 your time. I really appreciate it in the  
15 middle of a deposition. I know your

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16 schedule is tight.  
17               Secondly, your Honor, I just  
18 wanted to make a comment: After your July  
19 11th ruling for Mr. Pappas to say they  
20 promptly complied, here we are six weeks  
21 later and we finally get Dr. Davis, but,  
22 at any rate, your Honor, as far as the  
23 substance goes, I want to read to you what  
24 your Honor said. It said, "You go  
25 ahead..." -- this is your Honor

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2 speaking -- "You go ahead and give up  
3 Dr. Davis again, but the questioning  
4 should be limited to the newly produced  
5 material or questions related to newly  
6 produced material or questions that are  
7 related to the I don't know that emerge  
8 during her individual deposition." That's  
9 the basis, your Honor -- that is one of  
10 the bases that we began asking Dr. Davis  
11 about Waldheim and the fact that  
12 Galanthamine was being used to treat  
13 Alzheimer's long before Dr. Davis ever  
14 came up with her idea.

15               The second concept is, your  
16 Honor, there is -- a secondary  
17 consideration under the law is also called  
18 simultaneous invention, and we want to

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19 probe her as representative to Synaptech  
20 about the nature of the simultaneous  
21 invention of using Galanthamine to treat  
22 Alzheimer's. It's certainly a fair topic  
23 and certainly covered by our 30 (b) (6)  
24 notice.

25 Your Honor, one other thing.

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2 HON. JORDAN: Hold on just a  
3 minute. Hold on just a minute. I know  
4 you have to have me on a speaker,  
5 because --

6 MR. GRACEY: No, actually on I'm  
7 on a handset.

8 HON. JORDAN: Then I need you to  
9 give me first the page cite ruling you  
10 said I was -- you quote -- you quoted me  
11 from July 11th. What page were you  
12 looking at?

13 MR. GRACEY: Page 13, your  
14 Honor, top of the page.

15 HON. JORDAN: Let me get there  
16 real quick. Then, moving forward off of  
17 that -- well, here's what I need you to  
18 respond to. I need you to respond to  
19 first the specific assertion that you're  
20 asking questions outside the 30 (b) (6)  
21 notice and topic. I mean, we'll get to

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22 what I take is your alternative argument.  
23 Maybe I'm wrong about this, but your other  
24 argument was that my oral ruling was such  
25 that you didn't have to stick with

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2 topics. If that's -- if that's one of  
3 your arguments, we can deal with that  
4 later. But first I want you to address  
5 the assertion that you are asking  
6 questions outside the noticed topics.  
7 MR. GRACEY: Well, that is --  
8 that assertion, with all due respect, is  
9 incorrect. As I pointed out, the  
10 simultaneous invention is a secondary  
11 consideration, and that is something that  
12 we would like to probe and we are going to  
13 produce to your Honor at the bench trial  
14 testified that Waldheim, at very least,  
15 simultaneously invented the use of --  
16 using Galanthamine to treat Alzheimer's.

17 HON. JORDAN: Which numbered --  
18 I'm sorry, that is -- numbered topic are  
19 you looking to say that -- asking this  
20 about the Waldheim references within what  
21 you put them on notice of?

22 MR. GRACEY: Sure, your Honor.  
23 That is topic 13, your Honor, and we don't  
24 list out all the -- we list the case,

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25 which is the John Deere case. The topic

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2 12 has the secondary consideration on  
3 commercial success and topic 13 has all  
4 the other secondary considerations other  
5 than commercial success.

6 HON. JORDAN: Okay. Now, we'll  
7 pursue this a little bit further, but I  
8 also want you to answer the charge that  
9 Mr. Pappas's made on this call, that he  
10 asked you this same sort of question that  
11 I'm asking, and you just wouldn't engage  
12 in the discussion, where he was asking,  
13 "So what topic exactly are you pointing  
14 to?" and you folks just wouldn't respond  
15 to that.

16 MR. GRACEY: Your Honor, we  
17 started out the deposition with about a  
18 ten-minute conversation where Mr. Pappas  
19 made his position known and we said we  
20 believe at the outset of the deposition  
21 any of the I don't knows that Bonnie gave,  
22 Dr. Davis gave, in her personal deposition  
23 were fair game. He said he disagreed and  
24 then there was -- I mean, once we had that  
25 position, we already knew we may have to

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2 come to your Honor, so when we were asking  
3 the question we were asking, this was  
4 under the gamut of the I don't knows and  
5 he already made his position clear that he  
6 was going to seek a protective order. So  
7 that's the reason.

8           And one other thing on that  
9 note, your Honor. Throughout these  
10 depositions, Mr. Pappas has, and his  
11 co-counsel have, been giving quite long  
12 speaking objections, and, you know, it's  
13 highly objectionable. I would like some  
14 guidance from your Honor on his  
15 objections, whether they should be just to  
16 form or whether he can give the long  
17 speaking objections that he's been  
18 giving.

19           With that being said, and  
20 perhaps you can do that at the end of the  
21 call, that's the context of the I don't  
22 knows and the reason that they're -- I  
23 mean we gave a proffer, I mean, at the  
24 very beginning of the deposition.

25           HON. JORDAN: All right.

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2 MR. PAPPAS: Your Honor, may I  
3 respond?

4 HON. JORDAN: Yeah, briefly.

5 MR. PAPPAS: First of all, your  
6 Honor, there have been no speaking  
7 objections. There have been statements of  
8 our position in an attempt to work this  
9 discovery dispute out. Second, your  
10 Honor, when we served 30 (b) (6) notices  
11 earlier in this case and asked the  
12 defendants to produce witnesses on their  
13 assertions of invalidity, I have that  
14 other transcript, your Honor advised the  
15 plaintiffs that those kinds of requests,  
16 such as 13 in this notice, were far too  
17 broad. Your Honor directed me that if we  
18 wanted to talk about specific issues, such  
19 as nonobviousness, secondary indicia, we  
20 were to tell the defendant what factors we  
21 wanted to integrate a 30 (b) (6) about  
22 with specificity, and we did that, your  
23 Honor.

24 So, third, they've never made  
25 simultaneously invention an issue in this

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2 case, and your Honor can look throughout  
3 the 30 topics. There is no reference to  
4 us producing a witness on alleged

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5 simultaneous invention. We've done our  
6 best, your Honor, to prepare one woman to  
7 testify on 30 topics, but they want to ask  
8 her about anything they want to ask her  
9 about.

10 HON. JORDAN: All right. I've  
11 got -- I'm confident I have both side's  
12 position here.

13 AlphaPharm, do you feel like you  
14 need to weigh in here?

15 MR. BERNSTEIN: Thank you, your  
16 Honor. Briefly, I hope. It's always been  
17 my understanding that when a side puts up  
18 a 30 (b) (6) witness and the questioner  
19 goes beyond the 30 (b) (6) topics -- and  
20 I'm not saying this was done here -- that  
21 the rulings are that the question should  
22 still be answered if the witness can  
23 answer them, and that's what I think  
24 should apply here, and I said so on the  
25 record: Please allow the witness to

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1  
2 answer the question and then, at the end  
3 of the day, we'll sum up all those  
4 instances where in this case Mr. Pappas  
5 believes that we've gone beyond the  
6 30 (b) (6), sum them all up and come to  
7 your Honor on another day and say, here's



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8 the situation, these are the -- these are  
9 the questions which one side believes go  
10 beyond the 30 (b) (6) and your Honor makes  
11 a ruling, instead of having to stop as we  
12 do here and spend all this time just on  
13 the one question.

14 So, in other words, the witness  
15 should be permitted to the answer the  
16 question if he or she can, even if one  
17 side believes that it's beyond the  
18 30 (b) (6) topics.

19 HON. JORDAN: Okay.

20 MR. PAPPAS: And, your Honor,  
21 you know, we disagree. We're here, we  
22 have a prepared witness prepared to give  
23 the corporate position.

24 HON. JORDAN: I gotcha. You  
25 don't have to --

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2 MR. PAPPAS: Thank you.  
3 HON. JORDAN: You don't need to  
4 respond any further. And, in fact, you're  
5 about to win, so you can relax. I'm  
6 telling you that, all, that it is not  
7 sufficient notice, in my view, to say the  
8 indicia and then think that that covers  
9 you if you're going to start pulling out  
10 specific references and inquiring about

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11 them. That's just not -- that just isn't  
12 fair notice, in my view. That is such a  
13 broad statement. I mean, you might as  
14 well have given her a notice that says,  
15 come prepared to talk about why your  
16 patent is or isn't valid. And you  
17 shouldn't expect the witness to come  
18 prepared for that.

19 And, more to the point, and this  
20 goes to the AlphaPharm position I've just  
21 heard, it's not incumbent upon people to  
22 show up at depositions and allow their  
23 witnesses to testify without decent  
24 preparation and then go back and try to  
25 figure out whether it was objectionable or

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2 not later.  
3 I think any one of you attorneys  
4 would be loath to set your client in front  
5 of opposing counsel to be grilled on a  
6 subject that they hadn't had a chance to  
7 discuss with their own counsel and then  
8 say, well, it's okay, because later we can  
9 talk to the judge about it. That's not  
10 the way the system is supposed to work and  
11 I think the plaintiffs are right to be  
12 concerned that that's what's going on  
13 here.

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14                   So I don't know enough about  
15 what's going forward with the deposition  
16 to know whether or not this is going to  
17 keep everybody on the reservation, but I  
18 can tell you that, based on this bit that  
19 I've had so far, the defense is off the  
20 reservation. Certainly, when I spoke on  
21 July 11th, I did not intend to override  
22 the federal rules of civil procedure which  
23 require you to give a notice of topics in  
24 a 30 (b) (6) notice. Nothing there was  
25 meant to relieve you of the obligation to

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2 give notice of what you intended to  
3 inquire about. To the extent you did give  
4 notice, that's the scope within which you  
5 have to operate and you should be talking  
6 to each other and not refusing to talk to  
7 each other about what that scope is when  
8 you run into a difficulty.  
9                   So that if there's a sensible,  
10 reasonable, rational relation between a  
11 question and a noticed topic, I expect the  
12 plaintiffs to sit back and let the witness  
13 answer the question, and if the defense  
14 can't point to that kind of a  
15 relationship, the defense should not be  
16 asking the question. Pretty much, it's

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17 that simple.  
18 I'll reiterate: To the extent  
19 any of these 30 topics -- and I haven't  
20 been sitting here reading through all of  
21 them -- to the extent that any of them are  
22 so broad that it really can't fairly be  
23 said to give somebody notice of what  
24 you're hitting them with, no, then  
25 that's -- you can -- you can bank on

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2 people sticking to this general rationale,  
3 which is 30 (b) (6) witnesses have a right  
4 to know the sorts of things you're going  
5 to be inquiring into with sufficient  
6 specificity to have been prepared to  
7 discuss it.

8 MR. GRACEY: You know, your  
9 Honor, if I may. Several things: First,  
10 it's just unbelievable that Bonnie Davis  
11 doesn't know, isn't prepared to discuss  
12 the nullity proceeding. This was her very  
13 invention that was being challenged and  
14 successfully so to the point where they  
15 had to reach a settlement.

16 That's the first issue, that she  
17 does know this, they're afraid of it, they  
18 don't want to talk about it, and they  
19 haven't been able to talk about it or

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20 wanted to talk about it at her personal  
21 dep or at this dep.

22 Secondly, with respect to this  
23 topic, reason why we didn't lay out every  
24 single topic, is because of the plaintiffs  
25 refused to answer our interrogatories

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2 until long into this case identifying what  
3 secondary considerations they were relying  
4 on. These are the same plaintiffs who  
5 wouldn't even identify what claim they  
6 were asserting. They wanted us to  
7 identify at the beginning of the case what  
8 claims we thought we infringed. They're  
9 just putting a horse behind -- in -- you  
10 know, behind the cart, not in front of the  
11 horse -- the cart and so --

12 HON. JORDAN: I can't solve that  
13 problem for you at this point. If you had  
14 come to me and said, judge, we can't frame  
15 a 30 (b) (6) notice because they won't  
16 tell us what they're relying on, or they  
17 haven't answered something properly -- I  
18 mean, you may have a valid gripe, but  
19 that's not something that I can address in  
20 this context, because the fair issue  
21 before me is, are you asking questions  
22 that are inside or outside the scope of

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23 what you noticed.

24 MR. GRACEY: It is inside.

25 HON. JORDAN: And when you say,

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2 well, we think it's inside because we said  
3 secondary considerations, I'm agreeing  
4 with the plaintiff that that doesn't tell  
5 somebody you're going to be talking about  
6 a nullity proceeding from 1995. If you  
7 had wanted to ask about that, you should  
8 have and certainly could have, if you say,  
9 well, she knew about it, she had to know  
10 about it, that tells me that you probably  
11 knew about it too. And if that's  
12 something you wanted to ask about, you  
13 should have put it in.

14 Look, I'm not -- I'm not looking  
15 at this circumstance and saying that  
16 anybody here is lily white and not  
17 involved in gamesmanship. I think there's  
18 gamesmanship going on on both sides.  
19 That's the message I'm getting here, that  
20 you were maybe playing your cards close to  
21 the vest, and maybe you have a legitimate  
22 reason to a certain extent, or maybe you  
23 were doing it because you wanted to have  
24 the advantage of some surprise, but  
25 whatever your motivations were, what I'm

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2 ruling on, and I hear you, you're unhappy  
3 with it, you go ahead and reserve your  
4 objection on the record, my ruling to you  
5 is, if you had a problem with what their  
6 discovery responses were and you thought  
7 you couldn't properly notice the  
8 deposition because of their failures,  
9 that's something you could have and should  
10 have brought up with me and with them  
11 promptly. You can't show up at the  
12 deposition and say, "They should have  
13 known this, certainly they knew about  
14 this."

15 I'm not looking at this -- I'm  
16 not looking at the Notice of Deposition  
17 that you did send and seeing this fairly  
18 noticed. So if you feel like now we're  
19 unfairly corralled because the plaintiffs  
20 gamed us by not responding, I can only  
21 answer you by saying that's something you  
22 should have spoken to me about in the  
23 course of trying to prepare a 30 (b) (6)  
24 and said, hey, judge, we can't -- we can't  
25 properly notice this deposition because

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2 they won't respond. And I could have  
3 dealt with it then. But I can't deal with  
4 it now while you've got the deponent in  
5 the room and plaintiffs can tell me in a  
6 way I think is persuasive, judge, it's  
7 just not on the list they sent.

8 MR. GRACEY: Your Honor, we did  
9 bring it to your attention and you did  
10 force them to answer the interrogatories.  
11 So you did resolve that and you resolved  
12 it in our favor. But I just think this is  
13 manifestly unfair, because they are  
14 playing hide the ball, your Honor, and  
15 this our last shot and this is going to be  
16 grossly prejudicial to the defendants in  
17 the preparation for their case. We're not  
18 allowed now to inquire about, from what  
19 I'm hearing from you, this -- this  
20 incredibly important issue in the case,  
21 and it sounds like -- and I want to get a  
22 clear record here. Are you also ruling  
23 that, therefore, we can't ask Dr. Davis,  
24 as the corporate representative of  
25 synaptech, about the unexpected benefits,

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2 about the long-felt need, about the  
3 skepticism and -- skepticism and -- in the  
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4 field and the failure of others, because  
5 those are secondary considerations that  
6 the plaintiffs are in as well? And if  
7 that's your ruling, then this deposition  
8 has just become incredibly, incredibly  
9 short.

10 HON. JORDAN: I believe my  
11 ruling is -- and, you're right, got to  
12 have a clear record here, that this has to  
13 be something they were fairly on notice  
14 of. So what --

15 MR. BERNSTEIN: Your Honor, this  
16 is Alan Bernstein. I hope I didn't  
17 interrupt you. My concern is we're going  
18 to go back in the deposition room and the  
19 questions are going to be asked and  
20 Mr. Pappas is going to say, that's outside  
21 the scope of any of these topics, give me  
22 and offer of why it is, and then we come  
23 and say, well, it is because of A, B, C,  
24 and he says, no, I disagree with you. So  
25 are we to come back to you on another

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2 telephone call?

3 HON. JORDAN: You know, if you  
4 have to do that, you have to do that. If  
5 I've got to baby-sit the lawyers in this  
6 case to get a deposition to move forward,

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7 I'll do it.

8 MR. BERNSTEIN: I appreciate  
9 that.

10 HON. JORDAN: I will say, it's  
11 not common to have to do that, but, if  
12 that's what's necessary, I will do it.  
13 And if I have to reconvene the deposition  
14 in my courtroom, I'll do it, but I'm  
15 expecting counsel on all sides to behave  
16 sensibly, and --

17 MR. BERNSTEIN: I hear you.

18 HON. JORDAN: -- and that's the  
19 bottom line. That ought to be clear.

20 Look, there are some things you  
21 could probably say, reasonably, if both  
22 sides are being reasonable, are within the  
23 scope of this notice, including as  
24 something as broad as secondary  
25 considerations.

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2 If there's something that's been  
3 revealed in discovery that the parties  
4 have discussed, that is something that's  
5 been an issue and it's been going back and  
6 forth in contention and interrogatories,  
7 everybody knows, hey, well, we're talking  
8 about commercial success here because  
9 we've had things going back and forth on

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10 that, and it's been an issue, it's been a  
11 subject of dispute, it's been an issue  
12 of -- in other depositions, well, you  
13 know, maybe you could fairly make the case  
14 to me that people know that's in the  
15 case. They know it because it's been  
16 discussed. It's been --

17 MR. GRACEY: But Waldheim is at  
18 the center of this case. Plaintiffs know  
19 it, they're fighting us about giving us  
20 documents about it. They've been claiming  
21 all kinds of privilege with respect to  
22 Bonnie Dave's deposition and the whole  
23 Waldheim nullity proceeding. I would  
24 challenge Mr. Pappas to tell you that they  
25 don't know anything about the nullity

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2 proceeding, that Bonnie Davis doesn't know  
3 anything, that they don't know it's at the  
4 heart of the case, because that's not the  
5 case; it's at the heart of the case. I  
6 just didn't spring this on her at this  
7 deposition. She was asked about it in her  
8 personal deposition and pulled all these I  
9 don't know or we got privilege objections  
10 launched.

11 HON. JORDAN: Well, I thought I  
12 heard Mr. Pappas tell me a moment ago that

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13 this has never been an issue in the case.  
14 Maybe I misheard him. But that's what I  
15 thought I heard.

16 MR. PAPPAS: Your Honor, what I  
17 said, that never -- they did not put us on  
18 notice. They wanted to talk to us about  
19 the nullity proceeding, and they've known  
20 about it, so my point was is that if they  
21 wanted to question about it, the 30 (b)  
22 (6), they could have put it in the  
23 notice. That's what your Honor has told  
24 us as a way to pave in the case so we know  
25 how to prepare the witness. This is a

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2 witness, your Honor, who has already been  
3 deposed for 14 hours.  
4 HON. JORDAN: Well, guess what,  
5 Mr. Pappas? She might be deposed more  
6 than that, because if it is in fact the  
7 case that what they're telling me is that  
8 nobody could be surprised by this, nobody  
9 could reasonably be surprised by this, and  
10 they'll get another crack at her. So what  
11 I'm trying to get you people to do is  
12 behave within the rules, in a reasonable  
13 fashion, so that evidence is on the  
14 record. That's what -- that's what the  
15 aim of the federal rules is, that's my aim

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16 here. Ultimately, some fact finder is  
17 going to have to sit down with you in a  
18 courtroom. Both sides are entitled to  
19 explore the other side's position.

20 If you're right, Mr. Pappas,  
21 that this is just out of left field,  
22 nobody could have fairly considered what  
23 came before this deponent today as  
24 something that she should have been  
25 prepared about, then they won't get

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2 another crack on this issue. And right  
3 now, I'm telling you, on this nullity  
4 thing, they don't get to pursue it further  
5 today. I don't have time to listen to you  
6 two develop a record on that.

7 But I'm not prepared at all to  
8 say that it's impossible that your witness  
9 might be in the witness chair again if  
10 it's apparent to me after further  
11 development that your side is the one  
12 that's being unreasonable in taking  
13 positions.

14 See, you lived with this case,  
15 every day, you folks. I don't know how  
16 many other cases you got, but obviously  
17 this is one that's absorbing a lot of  
18 people's time and effort and energy and

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19 attention.  
20 I want to do justice by you  
21 people and your clients, considering how  
22 much effort has gone into it. On this  
23 phone call, can I resolve all your  
24 disputes? No. I can't. Can I say that  
25 looking at this record I don't see

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2 something about a waldheim reference or a  
3 nullity proceeding, and, therefore, I feel  
4 comfortable saying it wasn't noticed and  
5 so you don't get it? Yes. I do feel  
6 comfortable saying that.  
7 Does that mean that if Bar can  
8 come forward and say, wait, Judge, that's  
9 just not fair because of all these other  
10 things that happened before, which should  
11 have put them on notice, if it could -- if  
12 it's within the realm of possibility, that  
13 your witness will be back testifying on  
14 this point. I won't make you have her  
15 testify today unprepared on that point,  
16 but I also won't say the subject is closed  
17 now and forever, because if they make a  
18 record before me that shows you folks  
19 should have been prepared and you weren't,  
20 and what I'm dealing with is hide the  
21 ball, as they assert, then she will be

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22 back.

23               So I hope everybody feels like  
24 when they go back in the room they're a  
25 little bit chastened and nobody feels like

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2 they're sitting in the position of power  
3 to just obstruct either, on one side, for  
4 the plaintiffs, or to run rough-shod over  
5 an unprepared witness on the other side.

6               MR. PAPPAS: Your Honor, we  
7 certainly, on behalf of plaintiff, we are  
8 prepared to have Dr. Davis testify about  
9 all these 30 topics.

10              HON. JORDAN: And that's all she  
11 has to do.

12              MR. PAPPAS: And she's ready to  
13 do that, your Honor.

14              HON. JORDAN: Then you guys can  
15 go back in this room and you can take this  
16 deposition up and it shouldn't be a  
17 problem. And if you hit a problem, you  
18 ought to be talking to each other how it's  
19 within a 30 (b) (6), and we have to get  
20 back on the phone today. And if we have  
21 to recess this and I have to require some  
22 more detailed description of topics, I  
23 guess we'll do that.

24              MR. BERNSTEIN: Your Honor, Alan  
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25 Bernstein, again, quickly.

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2 With reference to the seven-hour  
3 limit on depositions, would you please  
4 tell me if I'm correct in my belief that  
5 the time we spent in setting up this phone  
6 call and having it does not count toward  
7 the seven hours.  
8 HON. JORDAN: Yes, you're  
9 correct. That's deponent time. And now  
10 listen, speaking of conduct in  
11 depositions, it is the custom and practice  
12 in this court that depositions are not to  
13 be a platform for speaking objections. If  
14 you want to put a position on the record  
15 and the other side has any concern that it  
16 might affect the witness' testimony, you  
17 can reserve that position until a time  
18 when there's a break. If it's crucial  
19 that the position be put on immediately,  
20 you can excuse the deponent from the room,  
21 put it on the record and deal with it.  
22 The objections ought to be limited to  
23 specific statements that will signal the  
24 court if and when I have to address the  
25 admissibility of deposition testimony.



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2           So, the short of it is,  
3 everybody ought to know that speaking  
4 objections are out of bounds and they  
5 ought not be going on.

6           So, as to the specific issue,  
7 let's recap: The Waldheim reference, the  
8 nullity proceeding, unless and until the  
9 folks on the defense side of the table can  
10 persuade me that this is something that  
11 it's a shock to them that nobody could  
12 read this deposition notice and not  
13 understand it was in there, you bear the  
14 blame for that. If you wanted it and you  
15 knew about it, you should have had it in  
16 the notice. But I'm not cutting off your  
17 ability to come back to me on that.

18           As to the rest of the deposition  
19 issues, if you got 30 topics out there,  
20 you go ahead and run with them. And I  
21 can't give you, I don't think, any better  
22 effort and guidance than this. I'm not  
23 going to have a witness deposed on topics  
24 that weren't fairly signaled as the  
25 subject of discussion, nor will I tolerate

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2 an attempt to dodge issues that are  
3 solidly in the case and were fairly  
4 signaled to the other side. And if we  
5 have to have a whole other hearing to deal  
6 with it and for people to take their  
7 positions, I guess we'll go there. But  
8 I'm hoping we don't have to. So, having  
9 said that, I think that's about what I can  
10 do for you for now.

11 MR. PAPPAS: Thank you.

12 MR. BERNSTEIN: Thank you, your  
13 Honor.

14 MR. GRACEY: Your Honor, I just  
15 wanted to be clear, that, based on your  
16 ruling, therefore, are we not allowed to  
17 inquire Ms. Davis about any of the  
18 secondary considerations of  
19 nonobviousness, other than success -- I  
20 need it clear on the record, your Honor.

21 MR. PAPPAS: Your Honor, I can  
22 address that and again resolve an issue  
23 that hopefully you'll never have to take  
24 up.

25 HON. JORDAN: Why don't you see

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2 what you can do. I've tried to explain to  
3 you, and maybe I haven't done it  
4 effectively, that that is such a broad

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5 topic that it could well be that you've  
6 set it up in a way where I'm going to have  
7 to rule against you on certain things.  
8 However, if the other side and you are  
9 able to agree that, yeah, this was in it,  
10 then everybody knew this was in it based  
11 on our previous exchanges, then you can  
12 inquire about it. So there's something  
13 for you to discuss there. And I can't  
14 give the yes or no that you're pressing  
15 for.

16 MR. GRACEY: The reason I say  
17 it's really not that broad, there's about  
18 six secondary considerations other than  
19 ground case, and so that it sounds like  
20 there's -- this would encompass, you know,  
21 40 topics in and of itself and it really  
22 does that, but I just got to know whether  
23 we're going to be allowed to go forward on  
24 that or not. And if we're not, we're not,  
25 and we'll deal with that however we end up

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2 dealing with it. But if we are, I just  
3 want Mr. Pappas to hear from your Honor,  
4 here's what we are our allowed and here's  
5 what we are not allowed to do. And I want  
6 the record clear, if we're not allowed to  
7 discuss any of them, if that's the

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8 ruling --  
9 HON. JORDAN: You've heard wrong  
10 then. So let me try to say it again. I'm  
11 aware of what the Graham secondary  
12 consideration factors are. What I've  
13 tried to put you folks straight on is, I'm  
14 not going to have you pull out references  
15 to some foreign proceedings and say, oh,  
16 this relates to this, and, therefore, it  
17 is something they should have known about  
18 in this context. If you have questions  
19 about those Graham factors, fine. If you  
20 have specific questions about documents  
21 that are in the case and that the parties  
22 have discussed and have been the subject  
23 of previous interactions in such a way  
24 that you can persuade me everybody knew  
25 this was going to be in this deposition,

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2 there's no way that a rational person  
3 couldn't have fairly understood that, then  
4 you can ask about it.  
5 So you ought to ask your  
6 questions, and if they're going to object,  
7 you make them go on record as objecting  
8 and you make your record. So what I'm  
9 telling you is, I can't at this point say,  
10 well, the judge said I can't ask anything,

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11 so I'll -- so that's done. What I've  
12 tried to tell you is, I can't give you  
13 that definitive a ruling, because I don't  
14 know what your course of discovery is.  
15 I can tell you that your topic,  
16 as a general statement, is so broad in  
17 this context as to be problematic, and it  
18 has caused a problem. If you wanted the  
19 waldheim and the nullity stuff, you should  
20 have noticed it. It's too broad to say  
21 it's covered by secondary considerations,  
22 but that doesn't mean there may not be  
23 other topics that fit within secondary  
24 considerations that you can fairly ask  
25 about.

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2 So you go ahead and ask your  
3 questions, you make him object, you guys  
4 make your record, and we'll deal with it  
5 when you've made your record. That's  
6 definitive and clear for you now?  
7 MR. GRACEY: Yes.  
8 HON. JORDAN: Okay. I will need  
9 a copy of this transcript, so I'll ask the  
10 court reporter and the parties to please  
11 arrange, because I got the feeling that we  
12 may have to revisit this. And, if we do,  
13 I'd like us all to be able, even though I

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14 sense Bar's counsel's frustration here, he  
15 feels this is about as clear as mud --  
16 that may be the case -- I hope not -- but,  
17 if it is, at least we're going to have the  
18 muddy record before us, if we ever have to  
19 get back together on this.

20 MR. PAPPAS: We'll make sure,  
21 your Honor, you get a copy.

22 MR. GRACEY: I just feel that  
23 Janssen and Synaptech are being awarded  
24 for hiding the ball, and that's the game  
25 they've been playing throughout this

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1  
2 litigation. I just -- that's the  
3 frustration you're hearing.

4 MR. PAPPAS: Your Honor, I have  
5 to object to that.

6 HON. JORDAN: Please don't.  
7 There's enough time for you guys to talk  
8 it out in front of me later. You've got a  
9 witness now, she's a busy lady probably,  
10 she's, you know, not eager, I'm sure, to  
11 wait while we are pointing the finger at  
12 each other here. Take it back in the  
13 room, get done what you need to do, Bar,  
14 make your record. If you can persuade me  
15 that, yeah, this has been hide the ball  
16 and it's been unfair, I won't hesitate to

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17 make them bring her back.

18 MR. GRACEY: Thank, your Honor.

19 HON. JORDAN: All right, we're

20 done.

21 (Telephone conference

22 terminates.)

23 (Time noted: 12:11 p.m.)

24 (Recess.)

25

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